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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11
EXAMINER

SHERRER, CURTIS EDWARD

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,435

Applicant(s)

WEERASINGHE ET AL.

Examiner

Curtis E. Sherrer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/27/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have amended their claims to include the phrase “beverage . . . having a rigid form” or something to that effect. While applicants refer to the invention as being able to be formed onto a stick (with reference to the prior art composition), applicants claim a beverage rather than some type of “Popsicle.”

Applicants have also amended their claims to include the limitation of “>50 C” to define the phrase “hot water,” but the specification does not provide basis for the claimed, unlimited temperature range.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 7, 8, 15, 16, 31 and 32 are indefinite because the scope of the term “about “ is unknown. Claim 4, and now claim 31, are indefinite because the scope of the term “essentially” is unknown. Applicants respond that the terms about and essentially are tested for their definiteness in view of the specification. Because applicants have not cited to any portion of the specification that defines these terms, said terms are considered to be without definite scope.

All the claims are considered indefinite because applicants now claim a “beverage . . . having a rigid form” or something to that effect. The use of this phrase is indefinite because a “beverage” is commonly defined as “a drinkable liquid” and something that is rigid is not liquid.

Claim 30 is indefinite because the scope of the term “shaped in the form of an ice-stick” is unknown.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 9-14 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Klose et al. (PCT/US95/13242)(hereinafter Klose) for the reasons set forth in the last Office Action.

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Claims 1, 3-6, 9-14 and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Oshimura et al. (Japanese Pat. No. 4-258282)(hereinafter Oshimura) for the reasons set forth in the last Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 8, 15, 16, 18-23, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshimura or Klose for the reasons set forth in the last Office Action.

Response to Arguments

Applicants' arguments filed 06/27/03 have been fully considered but they are not persuasive.

With regard to the prior art rejections, applicants argue that both of the prior art references to not teach or teach away from the claimed products and processes. Specifically, it is argued that Klose does not teach a product that can be placed on a stick. Because applicants do not claim a stick product or a process that includes placing it on a stick, this argument is not found persuasive. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants argue that Klose only discloses a “slushy frozen cocktail product” that is partly melted or semi-frozen. In fact, Klose also teaches the production of a beverage that “can be “frozen” or “semi frozen.” (Page 7). Klose also states that “[l]ower amounts of beverage alcohol decrease the beverage’s resistance to freezing, thereby producing a product which may freeze prematurely and more solidly” (Page 9, bottom). Also, it is stated that the stabilizing system produces a product that is “frozen or semi-frozen.” (Page 10, bottom). Clearly, Klose makes a distinction concerning frozen and semi-frozen products.

Klose teaches those limitations set forth in the claims and therefore the Klose products and processes anticipate the claims. If there is a feature or step that applicants perform to obtain a product different from what Klose discloses, then it should be claimed.

With regard to the teachings of Oshimura, applicants argue that, even though the patent teaches the production of a product that “has to be smashed before drinking,” Oshimura teaches away from a beverage with a rigid form. But Oshimura teaches a beverage with a rigid form. The concept of “teaching away” applies in prior art rejections based on obviousness and not anticipation.

With regard to the obviousness rejections, applicants argue that the amounts of stabilizers are critical to the production of a frozen beverage. If this is the case, these limitations should be incorporated into the independent claims.

Further, applicants admit that “[o]ne skilled in the art is aware that changing the amount of one component of the beverage or substituting one ingredient for another may cause an undesirable change in the characteristics of the product which would require the amounts of all of the other ingredient to be carefully balanced in order to arrive at a suitable product.” In other

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words, the amounts of the individual stabilizer components are result effective variables that would commonly be optimized by those in the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis E. Sherrer whose telephone number is 703-308-3847. The examiner can normally be reached on Tuesday-Friday, 8AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3602 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read 'C. E. Sherrer', with a long horizontal flourish extending to the right.

Curtis E. Sherrer
Primary Examiner
August 26, 2003